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In re Application of :  
CAPRATHE et al. :  
Application No.: 09/674,812 : DECISION ON PETITION  
PCT No.: PCT/US99/09463 :  
Int. Filing Date: 30 April 1999 :  
Priority Date: 05 May 1998 :  
Attorney Docket No.: BBI-5060CPUS :  
For: SUCCINAMIDE INHIBITORS OF  
INTERLEUKIN-1B CONVERTING  
ENZYME

This is a decision on applicants' "Request for Withdrawal of Notification of Abandonment" which is being treated as a Petition under 37 CFR 1.181 filed in the Patent and Trademark Office (PTO) on 21 December 2001.

#### BACKGROUND

On 30 April 1999, applicants filed international application no. PCT/US99/09463 which claimed a priority date of 05 May 1998. A proper Demand was filed with for International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 06 November 2000 (05 November 2000 was a Sunday).

On 06 November 2000, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee and a copy of the international application.

On 19 December 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for providing the oath or declaration later than 30 months from the priority date was required. The notification set a one (1) month period for response. The notification was mailed to the attorney of record listed on the 06 November 2000 Transmittal Letter.

On 04 September 2001, applicants filed: Status Inquiry Letter; Notification of Change of Mailing; Notification of Change of Attorney Docket Number; copy of Revocation of

Postcard card.

On 11 September 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 19 December 2000 within the time period set therein. The Notification of Abandonment was mailed to the attorney of record listed on the 06 November 2000 Transmittal Letter.

On 21 December 2001, applicants filed "Request for Withdrawal of Notification of Abandonment." Applicants state in their present petition that, "[a]t the request of the owner of the above referenced patent application, Ms. Arnold transferred . . . the complete Foley Hoag prosecution file . . . to Lahive & Cockfield."

### DISCUSSION

With regards to applicants' request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Regarding item (1) above, the practitioner from Foley, Hoag, & Eliot has not attested that the Office action was not received. The declaration of Theresa A. Bresnahan, Patent Docket Administrator for the Patent Department of the law firm of Foley, Hoag, & Eliot, was not considered because the statement was not made by a practitioner pursuant to 37 CFR 1.31.

Concerning item (2) above, applicants have not provided a statement from attesting that a search of the file jacket and docket records indicates that the papers were not received.

With regard to item (3) above, petitioner has not provided a copy of the Foley, Hoag, & Eliot's docket record where the notification mailed 19 December 2000 would have been entered had it been received or referenced such copies in the statement by practitioner. Specifically, applicant must provide a copy of counsel's docket records for 19 January 2001 (ie, the date on which the response was due) showing all applications for which a response was due on that date.

Thus, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

CONCLUSION

The Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 has been considered, however, for the reasons indicated above, the petition stands **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." No additional fee is required. Extensions of time under 37 CFR 1.136(a) are permitted.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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